

REMARKS / ARGUMENTS

I. Status of the Claims

Claims 1-44 remain pending in this application. Claims 1-3, 18, 19, 33, 36, 37, 41, and 42 are currently amended herein. New claims 45-54 have been added herein.

II. Request for Consideration of References Cited in Supplemental IDS Mailed February 15, 2005 by Applicants

On February 15, 2005, Applicant's representative John W. Wustenberg filed a Supplemental Information Disclosure statement referencing 5 U.S. patents, two published French patent applications, and a foreign communication from a related counterpart application. Applicants have accessed the Office's PAIR website, and have found thereon an indication that this Supplemental IDS was received by the Office on February 18, 2005. However, none of the references cited in this Supplemental IDS appear on the Examiner's list of references cited by Applicants and considered by the Examiner. Accordingly, Applicants expressly request that the Examiner consider the references cited on the aforementioned Supplemental IDS, and subsequently indicate such consideration in the next communication that the Examiner issues in this case.

III. Rejection of Certain Claims Under 35 U.S.C. § 102(b)

Claims 1-3, 13, 14, 16, 18, 19, 28, 29, 33, 36-38, and 40-42 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,349,204 to Malone (hereinafter, "*Malone*"). Applicants respectfully traverse.

Regarding *Malone*, the Examiner has stated:

Malone discloses a fluid inflatable packer comprising an inflatable element 21 exposed to an interior of the fluid inflatable packer, the inflatable element inflates and deflates with process fluid pressure in the interior of the fluid inflatable packer; a mandrel 40 having a plurality of openings 42 along its length; the inflatable element disposed about the mandrel; the interior of the fluid inflatable packer being an interior of the mandrel; the inflatable element exposed to the interior of the mandrel through the openings; the inflatable element inflates and deflates with process fluid pressure in the interior of the mandrel; an inflation chamber (next to openings 42) formed between the inflatable element and the

mandrel; the inflatable element inflated by unfiltered process fluid provided through the openings to the inflation chamber; one or more slats or bar-like connecting elements 25 coupled between an upper sub 33 and a lower sub 34; the inflatable element disposed about the connecting elements; the inflatable element exposed to the interior of the fluid inflatable packer through openings between the connecting elements; at least half of the inflatable element is exposed directly to the interior of the fluid inflatable packer; an open mandrel 40 having a longitudinal passageway; an inflatable element disposed about the open mandrel; the open mandrel directly exposes the inflatable element to process fluid and process fluid pressure in the longitudinal passageway; at least one tensioning collar 31 maintaining the inflatable element in tension about the open mandrel when the fluid inflatable packer is in an inflated state; and the inflatable element inflates and deflates with process fluid pressure in the longitudinal passageway.

This reference also discloses a method of treating a subterranean formation, comprising the steps of: pumping a process fluid to a fluid inflatable packer 10; passing without filtration the process fluid through the inside of the fluid inflatable packer to an inflatable element of the fluid inflatable packer; inflating the inflatable element with the unfiltered process fluid; passing the unfiltered process fluid through an open mandrel of the fluid inflatable packer to the inflatable element of the fluid inflatable packer; inflating the inflatable element with process fluid pressure in the open mandrel; deflating the inflatable element with process fluid pressure in the open mandrel; inflating a fluid inflatable packer with process fluid pumped down a tubing string (col. 2, line 48) to a process tool 40 coupled to the fluid inflatable packer; deflating the fluid inflatable packer by dropping process fluid pressure in the tubing string; positioning a downhole tool assembly being a packer 10 and a process tool 40; pumping a process fluid to the packer and the process tool; inflating the packer by passing the process fluid into an inflation chamber of the packer; performing the treatment (testing, col. 2, line 48) using the process fluid; terminating pumping of the process fluid; and deflating the packer by passing the process fluid out of the inflation chamber as a result of a drop in process fluid pressure.

(Office Action, at 2-3.) Applicants respectfully disagree with the Examiner's statements, and provide the following preliminary remarks before addressing each independent claim individually.

First, Applicants respectfully submit that *Malone* has not been shown to disclose:

one or more slats or bar-like connecting elements 25 coupled between an upper sub 33 and a lower sub 34; the inflatable element disposed *about* the connecting elements; the inflatable element exposed to the interior of the fluid inflatable packer *through openings between the connecting elements*. . .

as stated by the Examiner. (Office Action, at 2 (emphasis added).) Rather, *Malone's* slats or bar-like elements 25 are themselves disposed about *Malone's* inflatable element 21, surrounding element 21. *See Malone*, Col. 2, lines 54-59 ("Surrounding the sleeve 21 are a plurality of . . . reinforcing slats 25"); *see also Malone* Fig. 2 (depicting element 21 disposed inwardly from elements 25). Moreover, the inflatable element 21 of *Malone* is not exposed to the interior of the packer through openings between elements 25; rather, *Malone's* element 21 is exposed to the interior of the packer through radial ports 42 disposed along the bore of rigid mounting sleeve 40. *See Malone*, Col. 2, lines 64-68 ("fluid pressure may be conveniently applied through the bore of the rigid mounting sleeve 40 and thence directed outwardly against the inner surfaces of the inner elastomeric sleeve 21 through a plurality of radial ports as at 42"). Furthermore, *Malone* has not been shown to be unambiguous as to whether openings even exist between bar-like elements 25. *See id.*, Col. 2, lines 55-59 ("Slats 25 . . . are disposed in an annular array with the side walls of each slat being overlapped by the side walls of an adjacent slat, as best shown in Fig. 4").

Next, Applicants respectfully submit that *Malone* has not been shown to disclose:

passing *without filtration* the process fluid through the inside of the fluid inflatable packer to an inflatable element of the fluid inflatable packer; inflating the inflatable element with the *unfiltered* process fluid; passing the *unfiltered* process fluid through an open mandrel of the fluid inflatable packer to the inflatable element of the fluid inflatable packer. . .

as stated by the Examiner. (Office Action, at 2 (emphasis added).) Rather, Applicants respectfully assert that the Examiner has not shown *Malone* to expressly disclose the use of *unfiltered* process fluid. Applicants respectfully submit that the Examiner simply has not identified an affirmative teaching by *Malone* that the process fluid used is unfiltered. Moreover, Applicants respectfully assert that *Malone* has not been shown to inherently disclose unfiltered process fluid, as one of ordinary skill in the art could conclude that *Malone's* packer was intended for use with process fluid that had been filtered at a point upstream of the packer. *See* MPEP § 2112 ("In relying upon the theory of inherency, the examiner must provide a basis in

fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” (citation omitted)(emphasis added)). Applicant respectfully asserts that the Examiner has not provided a basis in fact and/or technical reasoning to reasonably support the determination that the process fluid used in *Malone*’s inflatable packer *necessarily* must be unfiltered.

Applicants next respond to the Examiner’s grounds for rejection by reviewing each independent claim individually.

Applicants have amended claim 1 to recite that the inflatable element of the fluid inflatable packer inflates and deflates with *unfiltered* process fluid pressure in the interior of the fluid inflatable packer. Applicants respectfully submit that the Examiner has not shown *Malone* to disclose a fluid inflatable packer having an inflatable element that inflates and deflates with *unfiltered* process fluid pressure in the interior of the fluid inflatable packer. To anticipate a claim under 35 U.S.C. §102(b), a reference must teach or suggest each and every limitation of the subject claim. MPEP § 2131. Because *Malone* has not been shown to teach a fluid inflatable packer having an inflatable element that inflates and deflates with *unfiltered* process fluid pressure in the interior of the fluid inflatable packer, it has not been shown to teach or suggest every element of Applicants’ independent claim 1, as amended.

Regarding independent claim 18, Applicants have amended this claim to recite that the inflatable element of the fluid inflatable packer inflates and deflates with unfiltered process fluid provided to the inflation chamber. Applicants respectfully submit that the Examiner has not shown *Malone* to disclose a fluid inflatable packer having an inflatable element that inflates and deflates with unfiltered process fluid provided to the inflation chamber. To anticipate a claim under 35 U.S.C. §102(b), a reference must teach or suggest each and every limitation of the subject claim. MPEP § 2131. Because *Malone* has not been shown to teach a fluid inflatable packer having an inflatable element that inflates and deflates with unfiltered process fluid provided to the inflation chamber, it has not been shown to teach or suggest every element of Applicants’ independent claim 18, as amended.

Regarding independent claim 33, Applicants have amended this claim to recite that the open mandrel directly exposes the inflatable element of the fluid inflatable packer to *unfiltered* process fluid and process fluid pressure in the longitudinal passageway of the open mandrel. Applicants respectfully submit that the Examiner has not shown *Malone* to disclose a

fluid inflatable packer having an open mandrel that directly exposes the inflatable element of the fluid inflatable packer to *unfiltered* process fluid and process fluid pressure in the longitudinal passageway of the open mandrel. To anticipate a claim under 35 U.S.C. §102(b), a reference must teach or suggest each and every limitation of the subject claim. MPEP § 2131. Because *Malone* has not been shown to teach a fluid inflatable packer having an open mandrel that directly exposes the inflatable element of the fluid inflatable packer to *unfiltered* process fluid and process fluid pressure in the longitudinal passageway of the open mandrel, it has not been shown to teach or suggest every element of Applicants' independent claim 33, as amended.

Regarding independent claim 37, Applicants have amended this method claim to recite that the inflatable element of the fluid inflatable packer is inflated *and deflated* with unfiltered process fluid. Applicants respectfully submit that the Examiner has not shown *Malone* to disclose a method of treating a subterranean formation in which the inflatable element of the fluid inflatable packer is inflated *and deflated* with unfiltered process fluid. To anticipate a claim under 35 U.S.C. §102(b), a reference must teach or suggest each and every limitation of the subject claim. MPEP § 2131. Because *Malone* has not been shown to teach a method of treating a subterranean formation in which the inflatable element of the fluid inflatable packer is inflated *and deflated* with unfiltered process fluid, it has not been shown to teach or suggest every element of Applicants' independent claim 37, as amended.

Regarding independent claim 41, Applicants have amended this method claim to recite that the fluid inflatable packer is inflated with *unfiltered* process fluid pumped down a tubing string to a process tool coupled to the fluid inflatable packer; and that the fluid inflatable packer is deflated by dropping *unfiltered* process fluid pressure in the tubing string. Applicants respectfully submit that the Examiner has not shown *Malone* to disclose a method of treating a subterranean formation in which the fluid inflatable packer is inflated with *unfiltered* process fluid pumped down a tubing string to a process tool coupled to the fluid inflatable packer; and the fluid inflatable packer is deflated by dropping *unfiltered* process fluid pressure in the tubing string. To anticipate a claim under 35 U.S.C. §102(b), a reference must teach or suggest each and every limitation of the subject claim. MPEP § 2131. Because *Malone* has not been shown to teach a method of treating a subterranean formation in which the fluid inflatable packer is inflated with *unfiltered* process fluid pumped down a tubing string to a process tool coupled to the fluid inflatable packer; and the fluid inflatable packer is deflated by dropping *unfiltered*

process fluid pressure in the tubing string, it has not been shown to teach or suggest every element of Applicants' independent claim 41, as amended.

Regarding independent claim 42, Applicants have amended this method claim to recite that the packer is inflated by passing *without filtration* process fluid into an inflation chamber of the packer; and that the packer is deflated by passing *unfiltered* process fluid out of the inflation chamber. Applicants respectfully submit that the Examiner has not shown *Malone* to disclose a method of treating a subterranean formation in which the packer is inflated by passing *without filtration* process fluid into an inflation chamber of the packer; and the packer is deflated by passing *unfiltered* process fluid out of the inflation chamber. To anticipate a claim under 35 U.S.C. §102(b), a reference must teach or suggest each and every limitation of the subject claim. MPEP § 2131. Because *Malone* has not been shown to teach a method of treating a subterranean formation in which the packer is inflated by passing *without filtration* process fluid into an inflation chamber of the packer; and the packer is deflated by passing *unfiltered* process fluid out of the inflation chamber, it has not been shown to teach or suggest every element of Applicants' independent claim 42, as amended.

Accordingly, Applicants respectfully submit that Applicants' independent claims 1, 18, 33, 37, 41 and 42, as amended, and the claims dependent therefrom, are not anticipated by *Malone*. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. 102(b) against these claims, and further request the timely issuance of a Notice of Allowance for these claims.

IV. Rejection of Claims 15 and 30 Under 35 U.S.C. § 103

Claims 15 and 30 stand rejected under 35 U.S.C. 103 as unpatentable over *Malone* in view of U.S. Patent No. 4,372,562 to Carter, Jr. (hereinafter, "*Carter*"). Applicants respectfully traverse.

The Examiner has stated:

Malone discloses a fluid inflatable packer comprising an inflatable element 21 exposed to an interior of the fluid inflatable packer; the inflatable element inflates and deflates with process fluid pressure in the interior of the fluid inflatable packer; the inflatable element disposed about connecting elements 25; and the inflatable element is exposed to the interior of the fluid inflatable packer through openings between the connecting elements but not cables.

Carter, Jr. presents cable connecting elements 60, 62 in a packer.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use cables, as presented by Carter, Jr., instead of slats since these elements are functional equivalents.

(Office Action, at 4-5.) Applicants respectfully traverse, and submit that *Malone* in view of *Carter* fails to disclose all elements of Applicants' claims 15 and 30. See MPEP 706.02(j) (stating that to establish a *prima facie* case of obviousness, a prior art reference (or references when combined) must teach or suggest all the claim limitations).

Applicants' claim 15 depends indirectly (through dependent claim 13) from independent claim 1. As noted above in Section III, Applicants respectfully assert that the Examiner has not shown *Malone* to disclose all elements of Applicants' independent claim 1, because the Examiner has not shown *Malone* to disclose, *inter alia*, a fluid inflatable packer having an inflatable element that inflates and deflates with *unfiltered* process fluid pressure in the interior of the fluid inflatable packer, as required by Applicants' claim 1. Moreover, as also noted in Section III, Applicants respectfully assert that the Examiner has not shown *Malone* to disclose the elements added by Applicants' dependent claim 13, because the Examiner has not shown *Malone* to disclose the additional elements recited by claim 13—one or more connecting elements coupled between an upper sub and a lower sub; wherein the inflatable element is disposed about connecting elements; and the inflatable element is exposed to the interior of the fluid inflatable packer through openings between the connecting elements. Applicants respectfully assert that *Carter* has not been shown to remedy the abovedescribed deficiencies of *Malone*, and note that *Carter* has thus far only been asserted to disclose the use of cable connecting elements 60, 62 in a packer. Because *Malone* in view of *Carter* fails to teach or suggest all elements of Applicants' claim 1, or claim 13, the Examiner has not shown that the cited combination discloses all elements of Applicants' claim 15, as required to render the claim obvious. MPEP 706.02(j).

Applicants' claim 30 depends indirectly (through dependent claim 28) from independent claim 18. As noted above in Section III, Applicants respectfully assert that the Examiner has not shown *Malone* to disclose all elements of Applicants' independent claim 18, because the Examiner has not shown *Malone* to disclose, *inter alia*, a fluid inflatable packer having an inflatable element that inflates and deflates with *unfiltered* process fluid provided to the inflation chamber, as required by Applicants' claim 18. Moreover, as also noted in Section

III, Applicants respectfully assert that the Examiner has not shown *Malone* to disclose the elements added by Applicants' dependent claim 28, because the Examiner has not shown *Malone* to disclose the additional elements recited by claim 28—one or more connecting elements coupled between an upper sub and a lower sub; wherein the inflatable element is disposed about the connecting elements; and the inflatable element is exposed to the interior of the fluid inflatable packer through openings between the connecting elements. Applicants respectfully assert that *Carter* has not been shown to remedy the abovedescribed deficiencies of *Malone*, and note that *Carter* has thus far only been asserted to disclose the use of cable connecting elements 60, 62 in a packer. Because *Malone* in view of *Carter* fails to teach or suggest all elements of Applicants' claim 18, or claim 28 the Examiner has not shown that the cited combination discloses all elements of Applicants' claim 30, as required to render the claim obvious. MPEP 706.02(j).

Accordingly, Applicant respectfully submits that claims 15 and 30 are not rendered obvious by *Malone* in view of *Carter*, and that the cited claims are novel and nonobvious over the art of record. Applicant respectfully requests withdrawal of the rejection of these claims under 35 U.S.C. 103, and further requests the timely issuance of a Notice of Allowance for these claims.

V. Rejection of Claim 17 Under 35 U.S.C. § 103

Claims 17 stands rejected under 35 U.S.C. 103 as unpatentable over *Malone* in view of U.S. Patent No. 6,575,251 to Watson et al. (hereinafter, "*Watson*"). Applicants respectfully traverse.

The Examiner has stated:

Malone discloses a fluid inflatable packer comprising an inflatable element 21 exposed to an interior of the fluid inflatable packer, wherein the inflatable element inflates and deflates with process fluid pressure in the interior of the fluid inflatable packer but not a screen.

Watson et al. show a screen 54 in a fluid inflatable packer 56 to restrict the flow of gravel (col. 9, line 41).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to include a screen, as shown by *Watson et al.*, in order to filter the fluid to inflate the packer.

(Office Action, at 5.) Applicants respectfully traverse, and submit that *Malone* in view of *Watson* fails to disclose all elements of Applicants' claim 17. *See* MPEP 706.02(j) (stating that to establish a *prima facie* case of obviousness, a prior art reference (or references when combined) must teach or suggest all the claim limitations).

Applicants' claim 17 depends from independent claim 1. As indicated above in Section III, Applicants respectfully assert that the Examiner has not shown *Malone* to disclose all elements of Applicants' independent claim 1, because the Examiner has not shown *Malone* to disclose, *inter alia*, a fluid inflatable packer having an inflatable element that inflates and deflates with unfiltered process fluid pressure in the interior of the fluid inflatable packer, as required by Applicants' claim 1.

Applicants respectfully assert that *Watson* does not remedy the deficiencies of *Malone*, because the Examiner has not shown that the inflatable packer of *Watson* can be deflated. Applicants note in this regard the significant emphasis that *Watson* places on permitting the inflatable element, once inflated, to remain in an inflated state. *See, e.g., Watson* Col. 5, lines 19-21 and 38-40. Applicants further note *Watson's* repeated teachings of the use of a check valve to prevent reverse flow out of the inflated packer. *See, e.g., Watson* Col. 5, lines 8-9 and 29-31; Col. 7, lines 49-51. Applicants also note that *Watson* expressly teaches that a benefit of *Watson's* invention is that "since the inflatable element is filled with a solid material instead of a liquid, a loss of hydraulic seal *will not necessarily result in the deflation of the tool, thus improving the reliability of the inflatable packer.*" *Watson*, Col. 5, lines 52-56 (emphasis added). Still further evidence of *Watson's* emphasis on avoiding deflation of the packer may be found at Col. 8, lines 44-49.

Accordingly, Applicants respectfully submit that claim 17 is not rendered obvious by *Malone* in view of *Watson*, and that the cited claim is novel and nonobvious over the art of record. Applicant respectfully requests withdrawal of the rejection of this claim under 35 U.S.C. 103, and further requests the timely issuance of a Notice of Allowance for this claim.

SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants have included check number 940966 in the amount of \$700.00 to cover the costs of new claims 45-54.

Applicants believe that there are no fees due in association with this filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this a Petition Therefor, and direct that any additional fees be charged to Baker Botts L.L.P. Deposit Account No. 02-0383, (*formerly Baker & Botts, L.L.P.*,) Order Number 063718.0130.

Respectfully submitted,

BAKER BOTTS L.L.P. (023640)

By: 

Thomas M. Morrow

Reg. No. 55,469

One Shell Plaza

910 Louisiana Street

Houston, Texas 77002-4995

Telephone: 713.229.4006

Facsimile: 713.229.7906

EMail: Tom.Morrow@bakerbotts.com

Date: September 21, 2005